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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,865	09/10/2003	Rex W. Halverson	2910-002	5087
22298	7590	01/10/2006		EXAMINER
MICHAEL H JESTER 505 D GRAND CARIBE CAUSEWAY CORONADO, CA 92118				NEGRON, ISMAEL
			ART UNIT	PAPER NUMBER
				2875

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,865	HALVERSON ET AL.	
	Examiner	Art Unit	
	Ismael Negron	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 11-18 is/are allowed.
- 6) Claim(s) 1,2 and 4-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on October 19, 2005 has been entered. Claim 1 has been amended. No claim has been cancelled, or added. Claims 1, 2 and 4-18 are still pending in this application, with claims 1 and 11 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WARMAN (U.S. Des. Pat. No. 63,528).

3. WARMAN discloses a chandelier having:

- **a frame (as recited in Claim 1), as seen in Figure 1;**
- **a plurality of hangers (as recited in Claim 1), as seen in Figure 1;**
- **a plurality of means for providing decorative illumination (as recited in Claim 1), as seen in Figure 1;**

- **the plurality of means for providing decorative illumination being mounted on the frame (as recited in Claim 1), as seen in Figure 1;**
- **the frame being configured in the form of a ring (as recited in Claim 2), as seen in Figure 2;**
- **a plurality of holders (as recited in Claim 4), as seen in Figure 1;**
- **the holders being connected to the frame (as recited in Claim 4), as seen in Figure 1;**
- **each holder removably receiving one of the decorative illumination means (as recited in Claim 4), as seen in Figure 1;**
- **the decorative illumination means being an incandescent lamp (as recited in Claim 7), as seen in Figure 1;**
- **the decorative illumination means and the holders being interspersed around the frame (as recited in Claim 8), as seen in Figure 1;**
- **the frame forming at least one metal ring (as recited in Claim 9), as seen in Figure 1; and**
- **artistic elements being attached to the frame (as recited in Claim 9), as seen in Figure 1.**

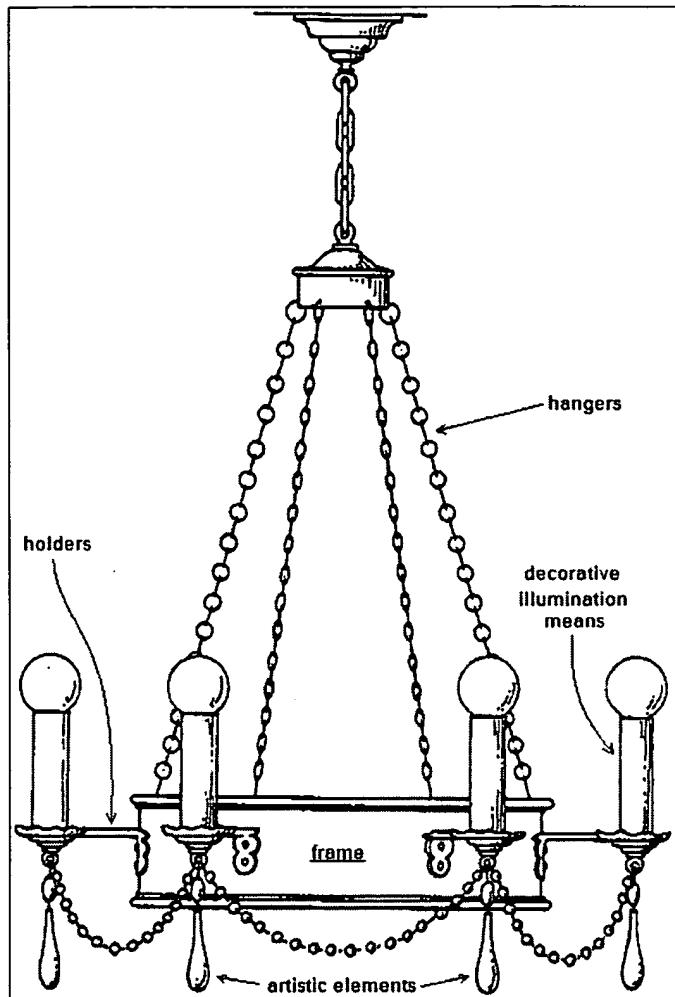


FIG. 1 of WARMAN (U.S. Des. Pat. No. 63,528) modified to identify elements corresponding to the structural elements of the claimed invention.

Claim 1 also recites the following functional limitations:

- the frame being configured to surround the post;
- the hangers being for each connecting the frame to a corresponding one of the struts;
- the hangers uniformly suspending the frame beneath the canopy;

- the hanger suspending the frame at a plurality of circumferentially spaced locations; and
- the hanger suspending the frame at a predetermined safe distance above a horizontal table surface through which the post extends.

4. WARMAN discloses all the limitations of the claims, except:

- the hangers being rigid (as recited in Claim 1);
- the decorative illumination means being a candle (as recited in Claim 5);
- the decorative illumination means being an oil lamp (as recited in Claim 6); and
- each hanger having double ended hooks (as recited in Claim 10).

5. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a candle (as recited in Claim 5), or an oil lamp (as recited in Claim 6) as the decorative illumination means of WARMAN, to be able to provide illumination for a patio umbrella even when an electrical power source was not available. In addition, the Examiner takes Official Notice of applicant's statements regarding specific types of light sources being devoid of any criticality to the subject matter of the invention, with incandescent lamps being one of many different light sources usable in the claimed chandelier (see paragraph 19, lines 2-6).

6. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use rigid hangers (as recited in Claim 1) or hangers having double ended hooks (as recited in Claim 10) as the hangers of WARMAN, since the Examiner takes Official Notice that such rigid double ended hooks are old and well known in the art. One would have been motivated to substitute the hangers of WARMAN for rigid double ended hooks to be able to easily connect and disconnect the patented frame from its supporting structure.

In addition, the Examiner further takes Official Notice of applicant's statements regarding specific type of hanger structures being devoid of any criticality to the subject matter of the invention, with rigid double ended hooks being one of many different hangers usable in the claimed chandelier (see paragraph 19, lines 6-11). It is also noted that the applicant specifically mentions the hanger structure of WARMAN (e.g. "links") as an equivalent to the claimed double-ended hooks (see paragraph 19, line 8).

7. Regarding the intended use recitations presented in the preamble of Claim 1 (e.g. "*for mounting on a patio table umbrella having a canopy supported by a plurality of ribs that extend radially from the upper end of a vertical post and a plurality of radially extending struts connected to the ribs*"), the applicant is advised that such recitations where considered having no patentable weight as the body of the claim fully and intrinsically sets forth all of the structural limitations of the claimed invention. The preamble of Claim 1, as stated in the previous Office Action, merely states the purpose or intended use of the invention, rather than providing any distinct definition of any of the claimed invention's limitations over the Prior Art. *Pitney Bowes, Inc. v. Hewlett-*

Packard Co., 51 USPQ2d 1161 (Fed. Cir. 1999). See also *Rowe v. Dror*, 42 USPQ2d 1550 (Fed. Cir. 1997).

8. Regarding the functional limitations, the applicant is advised that it has been held by the courts that the recitation that an element is adapted to (e.g. "suitable for", "configured to") perform a function, or serve in a given application, is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented frame of WARMAN was considered capable of performing, or being used, as claimed.

Allowable Subject Matter

9. Claims 11-18 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a combination collapsible umbrella, chandelier and patio table having a frame surrounding a vertical post of the patio table umbrella, such frame including a plurality of means for providing decorative illumination. The frame is connected to the umbrella struts by double-ended hooks positioned at plurality of circumferentially spaced locations, for uniformly suspending the frame from the struts

under the canopy of the umbrella at a safe distance above the horizontal surface of the patio table.

While collapsible umbrellas, chandeliers and patio tables are old and well known in the art, no prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the collapsible umbrella and patio table in combination with the particular structure of the claimed chandelier.

Relevant Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Crumley (U.S. Des. Pat. 70,540), **Friedman** (U.S. Des. Pat. 71,966), **Ganger** (U.S. Des. Pat. 134,482), **Schonbek** (Int. App. Pub. No. WO 91/19934) and **Lupien** (U.S. Des. Pat. 369,878) disclose a plurality of chandeliers supported by rigid double-ended hooks.

Response to Arguments

12. Applicant's arguments filed October 19, 2005 have been fully considered but they are not persuasive.

13. Regarding the Examiner's rejection of claims 1 and 10 under 35 U.S.C. 103(a) as being unpatentable over WARMAN (U.S. Des. Pat. No. 63,528), the applicant challenges the Examiners Official Notice of the use of double ended hooks for supporting chandeliers as old and well known in the art (applicable to Claim 10), and extends such challenge to the newly claimed rigid hangers (applicable to amended Claim 1) in case the Examiners decides to base an obviousness rejection on the same grounds.

In addition, the applicant argues that paragraph 19 of the specification (as originally filed) did not indicated "links" as equivalent to the claimed double ended hooks, but merely set forth examples of various alternative structures for suspending the chandelier, as per 35 USC § 112, 6th paragraph.

Regarding the Examiner's rejection of claims 2 and 4-9, the applicant present no arguments, except stating that such claims depend directly or indirectly from independent Claim 1 and would be allowable when/if the independent claim is allowed.

14. In response to applicant's challenge, the Examiner respectfully directs the applicant to Section 15 of the previous Office Action, where a collection of references evidencing the old and well known in the art status of ***rigid double-ended hooks*** for supporting chandeliers, was cited in anticipation of applicant's challenge.

However, for applicant's convenience the relevant references have been presented again in Section 11 of the instant Office Action.

15. In response to applicant's arguments that "links" were never presented as equivalent to the claimed double-ended hooks, but merely as examples of various alternative structures in accordance with 35 USC § 112, 6th paragraph, the applicant is respectfully advised that such arguments fly in the face of fact.

The specification disclosed links (such as the ones patented by WARMAN) as alternative structures readily available in the art, without presenting any advantage or functional difference between the claimed double-ended hooks and such alternative links.

In addition, applicant's arguments about complying with 35 USC § 112, 6th paragraph are irrelevant since the argued structure (the rigid hangers) was never presented in means-plus-function format required by the cited statute. However, if the claimed language reciting the plurality of hangers were to be interpreted as invoking 35 USC § 112, 6th paragraph, it would only affirm the rejection under WARMAN, as it would mean that the patented "links" are, indeed, admitted equivalents of double ended hooks.

16. Regarding applicant's statements on the "inappropriateness" of conducting a new prior art search when the applicant has not submitted new prior art or changed the nature of the claimed invention, while the Examiner admits that a careful and comprehensive search (commensurate with the limitations appearing in the most detailed claims in the case) must be made in preparing the first action on the merits, the applicant is advised that an Examiner must update the prior art search with every communication, to discover any document that might have become available after the

initial search. As the applicant will no doubt agree, it is the paramount duty of the Office to issue valid patents (emphasis added). Once the Examiner is made aware during such updated search, of a relevant reference, the newly discovered document (and its citations, if any) must be considered, and applied against the claims (if possible).

The Examiner also recognizes the dangers of extending prosecution by presenting new grounds for rejection after a first action when such new grounds are not necessitated by applicants amendments or newly presented art, however, such dangers are belittled when considered in light of the possibility of issuing a useless and invalid patent.

In addition, while applicants comments do present a valid issue, it is noted that applicant's portrayal of the Examiner's rejection as "moving target rejections" are somewhat inaccurate, as the applicant did not overcome any rejection, but merely presented in independent form dependent claims previously deemed to contain patentable subject matter. The applicant should rest assured that it is not the Examiner's intention to delay the grant or diminish the term of a patent, or burden the inventors with unnecessary additional legal fees and costs, but to meet the legal criteria for granting of the exclusive rights being claimed in the instant application for patent.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



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